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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/982,496

10/18/2001

Ryszard Sprycha

C-411

7480

27384 7590 04/06/2007
NORRIS, MCLAUGHLIN & MARCUS, PA
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EXAMINER

SHOSHO, CALLIE E

ART UNIT

PAPER NUMBER

1714

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

04/06/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/982,496

Applicant(s)

SPRYCHA ET AL.

Examiner

Callie E. Shosho

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-15 and 17-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-15 and 17-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. All outstanding rejections except for those described below are overcome by applicants' amendment filed 1/8/07.

Upon reconsideration, it is noted that claims 9-14 and 23-28 are now rejected utilizing Catena et al. (U.S. 5,338,785) in view of EP 621319 and Kuder et al. (U.S. 6,013,373) given that these claims do not require that the viscosity stabilizing, resolubility promoting water-soluble compound is organic base or inorganic/organic acid or aminoalcohol. These claims only further specify the members of the Markush group with respect to the water-soluble compound.

In light of these new grounds of rejection, the following action is non-final.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1, 3-15, and 17-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Catena et al. (U.S. 5,338,785) in view of EP 621319 and Kuder et al. (U.S. 6,013,373).

The rejection is adequately set forth in paragraph 7 of the office action mailed 7/7/06 and is incorporated here by reference.

Response to Arguments

4. Applicants' arguments regarding Zhu et al. (U.S. 6,251,175) and Smith et al. (U.S. 5,095,058) have been fully considered but they are moot in view of the discontinuation of the use of these references against the present claims.

5. Applicants' arguments filed 1/8/07 have been fully considered but, with the exception of arguments relating to Zhu et al. and Smith et al., they are not persuasive.

Specifically, applicants argue that Catena et al. is not a relevant reference against the present claims given that the exemplified inks of Catena et al. include water and thus, are aqueous.

However, attention is drawn to example 7 of Catena et al., pointed to by the examiner in the office action mailed 7/7/06, that discloses ink that does not comprise water.

Applicants argue that there is no disclosure in Catena et al. of water-soluble compound, i.e. base, aminoalcohol, acid, or aminoacid.

It is agreed that there is no disclosure in Catena et al. of water-soluble compound as presently claimed which is why Catena et al. is utilized in combination with EP 621319 that discloses the use of inorganic base such as sodium hydroxide, potassium hydroxide, or lithium hydroxide.

Applicants argue that EP 621319 only teaches phthalocyanine composition and teaches the use of water as a solvent.

While it is agreed that EP 621319 is drawn to compositions comprising phthalocyanine pigment, it is noted that example 7 of Catena et al. also discloses ink comprising phthalocyanine pigment. Further, it is noted that while the ink of EP 621319 can include either organic solvent or water, the use of water is not required which is evidenced by the examples of EP 621319 that do not utilize water.

Applicants argue that Catena et al. requires the use of cellulose acetate butyrate and specific copolymer distinct from known hot melt polyamide.

However, attention is drawn to example 7 of Catena et al. that discloses the use of Macrommelt 6239 that is well known, as disclosed by Kuder et al., as a hot melt polyamide. Further, while it is agreed that EP 621319 requires the use of cellulose acetate butyrate, on the one hand, in light of open language of the present claims with respect to the ink, i.e. “comprising”, it is clear that the ink is open to the inclusion of additional ingredients including cellulose acetate butyrate. On the other hand, EP 621319 is a teaching reference utilized only for its disclosure of using sodium hydroxide, potassium hydroxide, or lithium hydroxide in combination with phthalocyanine in inks.

Applicants also argue that there is no motivation to utilize EP 621319 given that EP 621319 discloses that it is the phthalocyanine derivative that improves the ink and not the hydroxide.

However, it is noted that EP 621319 discloses ink comprising phthalocyanine pigment and sodium hydroxide, potassium hydroxide, or lithium hydroxide and further discloses that that

ink comprising such combination has excellent fluidity and stability with time as compared to conventional ink comprising phthalocyanine alone (col.3, lines 3-6 and 44-45, col.5, lines 19-21, and col.10, lines 31-33). Attention is directed to example 3 that discloses ink comprising phthalocyanine and sodium hydroxide and to comparative example 5 that discloses ink comprising phthalocyanine but no sodium hydroxide. It is shown that the ink of example 3 has better gloss and fluidity.

Applicants also argue that there is no disclosure in either Catena et al. or EP 621319 of non-aqueous ink as presently claimed wherein a base, aminoalcohol, acid, or amino acid is added to promote resolubility and stabilize viscosity.


However, it is noted that page 10, lines 31-3 of EP 621319 discloses that the use of phthalocyanine and sodium hydroxide results in ink with increased stability. Further, given that Catena et al. in combination with EP 621319 discloses ink as presently claimed, it is clear that such ink would intrinsically possess stability and resolubility as presently claimed.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1714

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
4/1/07